

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed January 14, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 112, First Paragraph**

Claims 1-31 have been rejected under 35 U.S.C. § 112, first paragraph, for purportedly failing to comply with the written description requirement. In particular, the Examiner argues that there is no support in the original disclosure for “automatically” composing and transmitting an electronic message “without human intervention” as is recited or suggested by various of Applicant’s claims.

Although Applicant agrees that the terms “automatically” and “without human intervention” do not explicitly appear in Applicant’s original disclosure, Applicant respectfully asserts that such explicit recital is not required to satisfy the 35 U.S.C. § 112, first paragraph, written description requirement. As was noted in Applicant’s previous Response, the purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession*, as of the filing date of application relied upon, of the subject matter later claimed by him. *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *Application of Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). This possession requirement ensures that the applicant actually invented the later claimed subject matter at the time the patent application was filed. As stated by the Court of appeals for the Federal Circuit (hereinafter “Federal Circuit”):

Satisfaction of the description requirement ensures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that a *prima facie* date of invention can fairly be held to be the filing date of the application.

*Eiselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995).

With possession being the key to satisfying the written description requirement of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description simply concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

[A]ll that is required is that it [the applicant] ***reasonably conveyed*** to persons skilled in the art that, as of the filing date thereof, the inventor had ***possession*** of the subject matter later claimed by him.

*Eiselstein*, 52 F.3d at 1039, 34 USPQ2d 1467, 1470 (emphasis added).

In the present case, Applicant clearly reasonably conveyed that it had possession of composing and transmitting an electronic message “automatically” and “without human intervention”. As is described in relation to Figure 1, Applicant discloses a hard copy output engine 14 (such as a printer, copier, facsimile machine, or multifunction device) that includes a controller 15 that is associated with sensors 17. As is described by Applicant:

In one embodiment, when the sensors 17 report that a quantity of a consumable commodity (e.g., paper, toner or ink) associated with the hard copy output engine 14 has decreased to below a predetermined

threshold amount, or that malfunction of a dispenser of a consumable commodity exists, *the controller 15 initiates a data communication ultimately intended for transmission via the data path 20, as is described below in more detail with reference to Fig. 3.* Alternatively or additionally, the sensors 17 may log hours of operation and/or loading (such as number of pages handled) in order to determine when preventive maintenance is appropriate, or may report other malfunction of the hard copy output engine 14.

*Applicant's original specification, page 5, lines 19-28 (emphasis added).*

Later, in the description of Figure 3, Applicant describes operation of the controller as follows:

In the step S3, the consumable/maintenance item that warrants attention is added to a notification list. . . .

In the step S6, *the notification list is incorporated into an electronic message, and the electronic message is transmitted.*

*Applicant's original specification, page 7, lines 17-18; page 8, lines 5-6 (emphasis added).*

Still later in the specification, Applicant confirms that the above-described processes are conducted by the hard copy output engine controller with the following:

In one embodiment, at least a portion of the process P1 is carried out via the processor 15.

*Applicant's original specification, page 8, lines 24-25.*

From the foregoing disclosures, it is clear that Applicant had possession of the concept of a controller of a hard copy output engine automatically composing and transmitting an electronic message without human intervention. First, it is clear that the controller is completing, in at least some embodiments, the tasks described in relation to Figure 3. Furthermore, nowhere in the specification are the actions of a user described. In view of these facts, a person having ordinary skill in the relevant art would readily appreciate that it is the hard copy output engine controller that is composing and transmitting the electronic messages without human assistance. Indeed, this can be described as one of the primary purposes of the invention. As is described in Applicant's Background of the Invention in which the Applicant describes a problem to be solved by the invention:

***It is generally helpful to have a mechanism for scheduling and tracking orders*** of consumable commodities and/or service in keeping computer systems functional. For example, it is extremely helpful to ensure that adequate supplies of replacement paper and toner or ink are available when needed.

Coordination of orders for supplies can be very helpful to avoid over- or under-stocking of these consumable commodities, while still achieving the benefits of economies of scale by pooling orders to service multiple hard copy output engines, especially those using at least some of the same consumable commodities. However, in many business settings, ***the sheer number of diverse hard copy output engines being used in different aspects or divisions of the business may lead to confusion in maintaining adequate supplies of these consumable commodities and in scheduling replacement of consumable commodities as well as scheduling preventative maintenance.***

*What is needed is a way to facilitate scheduling replacement of consumable commodities, as well as scheduling preventative maintenance, for one or more hard copy output engines that are included in a network.*

*Applicant's original specification, page 2, lines 6-21.*

As would be clear to a person having ordinary skill in the relevant art, requiring a human to manually track consumable commodities and schedule preventative maintenance would not achieve the goal of “facilitating scheduling” of replacing such consumables and scheduling such maintenance.

In view of the above, Applicant respectfully submits that the written description requirement of 35 U.S.C. § 112, first paragraph, is satisfied in relation to claims 1-31. Applicant therefore requests the rejection be withdrawn as to those claims.

## **II. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1-31 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Hayward, et al. (“Hayward,” U.S. Pat. No. 6,629,134). Applicant respectfully traverses this rejection.

### **A. The Hayward Disclosure**

Hayward discloses web-based user support. More specifically, Hayward discloses a computer program that executes on a computer that responds to conditions that are sensed by a peripheral. Hayward, column 1, lines 26-30. In operation of the peripheral, a “peripheral condition” may occur that indicates a need to replace a consumable. Hayward, column 5, lines 10-13. In such a case, “the peripheral condition

is sent” by firmware to an application running on a computer 30, which indicates the condition to the user on a display of the computer. Hayward, column 5, lines 14-18.

The *user* is provided with the option of ordering the consumable. Hayward, column 6, lines 1-4. Specifically, when the *user* selects a “buy now” button from the computer, the application program launches a browser to access a purchase order screen, which the user can fill out. Hayward, column 7, line 66 to column 8 line 15. Once the *user* has filled out the purchase order screen, the browser either sends the purchase order to the manufacturer’s server, or launches an e-mail module to send the purchase order data to the manufacturer’s server. Hayward, column 8, lines 15-20.

## **B. Applicant’s Claimed Inventions**

Applicant claims methods, articles of manufacture, and control systems that pertain to status of a hard copy output engine. Applicant discusses these claims in the following.

### **1. Claims 1-7 and 21-25**

Applicant’s independent claim 1 provides as follows (emphasis added):

1. A method of scheduling an event with respect to a hard copy output engine, comprising:

detecting a first status of a first portion of the hard copy output engine from a first sensor incorporated in the hard copy output engine;

detecting a second status of a second portion of the hard copy output engine from a second sensor incorporated in the hard copy output engine;

*automatically composing an electronic message without human intervention, the message including both the detected first and second status; and*

*automatically transmitting the electronic message over a network without human intervention.*

As a first matter, Applicant reiterates that Hayward does not disclose “automatically composing an electronic message without human intervention” as is required by claim 1. To the contrary, as is described above, Hayward teaches a system in which the user is provided with the option of ordering a consumable. It is only when the user manually selects a “buy now” button from the computer when any electronic message is created by the “application” running on the user’s computer. Accordingly, Hayward fails to anticipate claim 1 for at least this reason. Applicant further notes that, Applicant has established that Applicant’s original specification satisfies the written description requirement of 35 U.S.C. § 112, first paragraph, in relation to the “automatically . . . without human intervention” limitations. Therefore, these limitations cannot be ignored when determining the patentability of claim 1.

Applicant further notes that Hayward does not disclose automatically composing an electronic message that includes “both the detected first and second status” as is also required by claim 1. Although Hayward describes sending messages about a “peripheral condition,” Hayward is silent about sending a message regarding multiple detected statuses. As is noted in Applicant’s specification, this distinction is significant. In particular, “coordination of orders for supplies can be very helpful to avoid over or under-stocking of these consumable commodities, while still achieving the benefits of economies of scale.” *Applicant’s specification*, page 2, lines 10-11.

As a further matter, Applicant notes that Hayward does not disclose “automatically transmitting the electronic message over a network without human intervention” as is required by claim 1. Instead, as is noted above, it is only when the user manually selects a “buy now” button from the computer when any electronic message is created by the “application” running on the user’s computer. Accordingly, human intervention is required in Hayward’s system.

Claims 1-7 and 21-25 are allowable for at least the above reasons.

## **2. Claims 8-14 and 26-28**

Applicant’s independent claim 8 provides as follows (emphasis added):

8. An article of manufacture comprising a computer usable medium having computer readable code embodied therein to cause a processor to:

detect a first status of a first portion of the hard copy output engine from a first sensor incorporated in the hard copy output engine;

detect a second status of a second portion of the hard copy output engine from a second sensor incorporated in the hard copy output engine;

*automatically compose an electronic message without human intervention*, the message *including both the detected first and second status*; and

*automatically transmit the electronic message over a network without human intervention.*

As is described above, Hayward does not teach “automatically composing an electronic message without human intervention” that includes “both the detected first and second status”, or “automatically transmitting the electronic message over a



network without human intervention”. It logically follows, therefore, that Hayward does not teach computer readable code that causes a processor to “automatically compose an electronic message without human intervention, the message including both the detected first and second status” or “automatically transmit the electronic message over a network without human intervention” as are required by independent claim 8. Accordingly, Hayward does not anticipate claim 8. Claims 8-14 and 26-28 are allowable for at least this reason.

### **3. Claims 15-20 and 29-31**

Applicant’s independent claim 15 provides as follows (emphasis added):

15. A computer implemented control system for a hard copy output engine, the system comprising:

a first sensor coupled to a first portion of the hard copy output engine, the first sensor being configured to provide a first status of the first portion;

a second sensor coupled to a second portion of the hard copy output engine, the second sensor being configured to provide a second status of the second portion; and

processor coupled to the first and second sensors and configured to:

detect the first status;

detect the second status;

***automatically compose an electronic message without human intervention, the message including both the detected first and second status; and***

***automatically transmit the electronic message over a network without human intervention.***

Regarding claim 15, Hayward does not teach a control system including a processor configured to “automatically compose an electronic message without human intervention, the message including both the detected first and second status” or “automatically transmit the electronic message over a network without human intervention”, for reasons described above in relation to claims 1 and 8. Claims 15-20 and 29-31 are allowable for at least this reason.

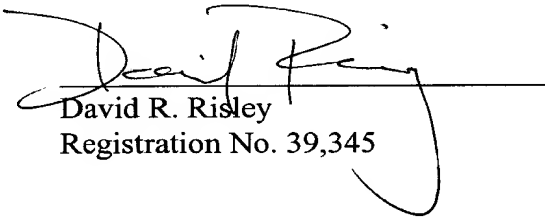
### **C. Conclusion**

Due to the shortcomings of the Hayward reference described in the foregoing, Applicant respectfully asserts that Hayward does not anticipate Applicant’s claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

### CONCLUSION

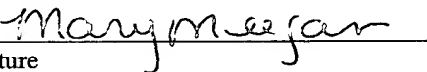
Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
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4-14-05

  
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